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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,274	05/09/2001	Ian Jones	36-1450	3238
23117 7590 02/04/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
TANG, KAREN C				
ART UNIT		PAPER NUMBER		
2451				
MAIL DATE		DELIVERY MODE		
02/04/2010		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IAN JONES and NGO NEUV

Appeal 2009-001385
Application 09/831,274¹
Technology Center 2400

Decided: February 4, 2010

Before JEAN R. HOMERE, DEBRA K. STEPHENS, and JAMES R.
HUGHES, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on May 9, 2001. This application is a national stage entry of PCT/GB99/03834, which has an international filing date of November 17, 1999. Further, PCT/GB99/03834 claims foreign priority to 98310090.0, which was filed on December 9, 1998. The real party in interest is British Telecommunications Public Ltd., Co. (App. Br. 3.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 14, 16 through 21, and 23 through 34. (App. Br. 5.) Claims 1 through 13, 15, and 22 have been cancelled. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse and enter a new ground of rejection.

Brief Summary of The Invention

Appellants invented a method and apparatus for maintaining communication within a circuit switched network, such as an Asynchronous Transfer Mode ("ATM") network. (Spec. 1, ll. 4-6.) In particular, the communication network utilizes a Uniform Resource Locator ("URL") including an identifier part, which identifies a resource as being accessible via a circuit switched network, an address part comprising a service parameter part, and the address of the resource. (Spec. 2, ll. 4-8.) According to Appellants, the claimed invention "enables the dynamic bandwidth and [quality of service ("QoS")] characteristics associated with ATM technology to be exploited and, importantly, helps to hide the complexity of establishing ATM [Switched Virtual Circuits ("SVCs")] from the end user." (Spec. 16, ll. 18-20.)

Illustrative Claim

Independent claim 14 further illustrates the invention as follows:

14. A method for operating a network circuit using a uniform resource locator (URL), the uniform resource locator comprising a circuit-switched identifier part identifying a resource as being accessible via a circuit-switched network, an address part comprising the address of the resource, and a service parameter part, wherein it is the circuit-switched identifier part which identifies the specific type of circuit switched network via which the resource is accessible, the

service parameter part determines parameters of a connection in the specific type of circuit switched network identified by the circuit-switched identifier part to the resource, and the uniform resource locator has the format:

<circuit-switched identifier part>://<service parameter part>*<address part> where * is a predetermined separator character.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Dominique Bonjour, et al., *Internet applications over native ATM*, 30 COMPUTER NETWORKS AND ISDN SYSTEMS 1097, 1097-1110 (1998) (hereinafter “Bonjour”).

UNIFORM RESOURCE LOCATORS (URL), 2-25 (Tim Berners-Lee et al. eds., 1994), (hereinafter “Lee”).

HF ZHU, DNS AND URL LEVEL ADDRESSING FOR PUBLIC CIRCUIT-SWITCHING NETWORK DEVICES <DRAFT-ZHU-DNS-URL-LEVEL-ADDR-00TXT>, (University of Texas-Austin, Oct. 1997) (hereinafter “Zhu”).

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 14, 16 through 21, and 23 through 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bonjour, Lee, and Zhu.

Appellants’ Contentions

Appellants contend that Lee’s disclosure of protocols suitable for use in relation to packet switched networks does not teach a URL that includes a circuit switched identifier part that identifies a resource as being accessible via a circuit switched network. (App. Br. 20-21.) In particular, Appellants argue that Lee’s disclosure of utilizing packet switched networks teaches

away from a URL comprising a circuit switched identifier part. (*Id.* at 22.) Further, Appellants contend that Zhu's disclosure of replacing telephone or fax numbers with URLs does not teach a service parameter part that determines parameters of a connection in a circuit switched network. (*Id.* at 24-25.) Additionally, Appellants allege that there is insufficient rationale for the proffered combination. (*Id.* at 22-24.)

Examiner's Findings and Conclusions

The Examiner finds that Bonjour's disclosure of using URLs in an ATM network, in conjunction with Lee's disclosure of how URL syntax and semantics vary in accordance with a specified scheme, teaches a URL scheme utilized in a circuit switched network as claimed. (Ans. 14-15.) Further, the Examiner finds that Lee does not teach away from the claimed invention because it is within the scope of the prior art analogous to the claimed invention. (*Id.* at 15-16.) Additionally, the Examiner finds that there is sufficient rationale for the proffered combination. (*Id.* at 15.)

II. ISSUE

The pivotal issue before us is whether Appellants have shown that the Examiner erred in concluding that that the combination of Bonjour, Lee, and Zhu render independent claim 14 unpatentable. In particular, the issue turns on whether the proffered combination teaches "[a] uniform resource locator [that] has the format: <circuit-switched identifier part>://<service parameter part>*<address part>," as recited in independent claim 14.

III. FINDINGS OF FACT

The following Findings of Fact (“FF”) are shown by a preponderance of the evidence.

Appellants’ Invention

1. Appellants’ Specification discloses that the first aspect of the claimed invention provides a digital signal encoded with a URL. (Spec. 2, ll. 4-5.) Additionally, Appellants’ Specification states that “[t]he [claimed] invention...encompasses a signal carrier carrying a signal in accordance with the first aspect of the [claimed] invention.” (Spec. 3, ll. 6-7.)

Bonjour

2. Bonjour generally relates to the adaptation of existing Internet applications to native ATM. (1098, Para. [1]-[3].) In particular, Bonjour discloses that existing Internet applications can operate directly over an ATM network. (*Id.*) Further, Bonjour discloses reusing existing Internet naming structures whereby ATM-attached application servers retain their usual Domain Name System (“DNS”) style names. (1099, Para. [2].)

Lee

3. Lee generally relates to a URL, including the syntax and semantics of formalized information for location and access of resources via the Internet. (1, Abst.)

4. Lee discloses that “URLs are used to locate resources that contain pointers to other resources.” (4, Sec. 2.3.) Lee discloses that an Hypertext Transfer Protocol (“HTTP”) “URL scheme is used to designate Internet resources accessible using HTTP.” (9, Sec. 3.3.) “An HTTP URL takes the form: http://<HOST><a>;<port>/<path>?<searchpart>.” (*Id.*)

Further, Lee discloses that new schemes should try to follow the same syntactic conventions of existing schemes. (17, Sec. 4.)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“‘On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.’”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

V. ANALYSIS

Claim 14

Independent claim 14 recites, in relevant part: “[a] uniform resource locator [that] has the format: <circuit-switched identifier part>://<service parameter part>*<address part>.”

As detailed in the Findings of Fact section above, Bonjour discloses adapting existing Internet applications to an ATM network thereby allowing each application to operate directly over the ATM network. (FF 2.) In particular, Bonjour discloses that each application will reuse their existing Internet DNS name. (*Id.*) We find that Bonjour’s disclosure teaches using a URL for applications within an ATM network, or a circuit switched network.

Further, Lee discloses utilizing a URL, including varying syntax and semantics formats, to locate and access resources via the Internet. (FF 3.) For example, Lee discloses that an HTTP URL scheme is used to designate Internet resources accessible using HTTP, e.g., `http://<HOST><a>:<port>/<path>?<searchpart>`. (FF 4.) Further, Lee discloses that new URL schemes should follow the same syntactic conventions of existing schemes. (*Id.*) We find that Lee's disclosure teaches utilizing a scheme dependent on a URL's syntax and semantics to access a resource. At best, we find that an ordinarily skilled artisan would readily appreciate that Bonjour's disclosure of using a URL for applications within a circuit switched network, in conjunction with Lee's disclosure of utilizing a scheme dependent on a URL's syntax and semantics to access a resource, teaches utilizing a scheme dependent on a URL's syntax and semantics to access a resource in a circuit switch network. However, we agree with Appellants' that the cited disclosures fall short of teaching or suggesting utilizing a URL that has the following format: `<circuit-switched identifier part>://<service parameter part>*<address part>`. In particular, we find the proffered disclosure to be wholly silent about including a service parameter as part of the URL. Further, we find that Zhu does not cure the noted deficiencies of Bonjour and Lee. It follows that the Examiner has improperly relied upon the combined disclosures of Bonjour, Lee, and Zhu to teach or suggest the disputed limitations.

Since Appellants have shown at least one error in the rejection of independent claim 14, we need not reach the merits of Appellants' other arguments. Accordingly, Appellants have shown that the Examiner erred in

concluding that Bonjour, Lee, and Zhu renders independent claim 14 unpatentable.

Claims 16 through 21 and 23 through 34

Because claims 16 through 21 and 23 through 34 also incorporate the limitations discussed above, we find that Appellants have also shown error in the Examiner's rejection of these claims for the reasons set forth in our discussion of independent claim 14.

VI. NEW GROUND OF REJECTION

35 U.S.C. § 101 Rejection

Independent claims 20 and 27 recite, in relevant part, “[a] machine-readable carrier tangibly carrying machine executable instructions and a URL for operating a network circuit using the URL.”

According to Appellants' Specification, machine-readable carriers carrying a URL may either be construed as a digital signal encoded with a URL or a signal carrier carrying a signal. (FF 1.) We find that such transmissions implicate a carrier wave or a signal modulated by a carrier over a transmission medium. Therefore, independent claims 20 and 27 encompass the use of a computer data signal embodied in a carrier wave to transmit information. A computer data signal embodied in a carrier wave is a transitory, propagating signal not within any of the four statutory categories and, therefore, non-statutory. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). It follows that independent claims 20 and 27 are directed to non-statutory subject matter.

Independent claim 21 recites, in relevant part, “[a] Uniform Resource Locator product with a uniform resource locator (URL).”

Patentable subject matter must fall within one of the categories set out in 35 U.S.C. § 101. *See In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009), *petition for cert. filed*, 77 U.S.L.W. 3680 (U.S. Jun. 2, 2009) (No. 08-1501); *Nuijten*, 500 F.3d at 1359. Appellants’ “URL product” claim appears, at first glance, to fall within the category of an article of manufacture, defined as a “tangible article or commodity” “resulting from the process of manufacture.” *Nuijten*, 500 F.3d at 1356 (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980); *Bayer AG v. Housey Pharms., Inc.*, 340 F.3d 1367, 1373 (Fed. Cir. 2003)). However, a close review of Appellants’ “URL product” claim shows that it does not recite a tangible article or commodity resulting from the process of manufacture, but rather encompasses either a digital signal encoded with a URL or a signal carrier carrying a signal. (FF 1.) We find that Appellants’ “URL product” claim implicates a carrier wave or a signal modulated by a carrier over a transmission medium. Therefore, independent 21 encompasses the use of a computer data signal embodied in a carrier wave to transmit information. A computer data signal embodied in a carrier wave is a transitory, propagating signal not within any of the four statutory categories and, therefore, non-statutory. *See Nuijten*, 500 F.3d at 1357. It follows that independent claim 21 is directed to non-statutory subject matter.

Because claims 23 through 26 also incorporate a “URL product” as discussed above, we find that these claims are also directed to non-statutory subject matter.

VII. CONCLUSIONS OF LAW

1. Appellants have shown that the Examiner erred in rejecting claims 14, 16 through 21, and 23 through 34 as being unpatentable under 35 U.S.C. § 103(a).

2. However, we have entered a new ground of rejection against claims 20, 21, and 23 through 27 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

VIII. DECISIONS

1. We reverse the Examiner's decision to reject claims 14, 16 through 21, and 23 through 34 as being unpatentable under 35 U.S.C. § 103(a).

2. We reject claims 20, 21, and 23 through 27 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

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REVERSED
37 C.F.R. § 41.50(b)

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